

REMARKS

Claims 1-12 were pending in the above-identified application. The Examiner indicated that claims 2, 9, and 10 were allowable and that claims 5 and 6 contained allowable subject matter. Claims 1-12 are voluntarily cancelled and have been replaced by new claims 13-36. Support for these added claims are identified in the following remarks. No new matter has been added by these amendments. Examination and reconsideration of all pending claims are respectfully requested.

*Allowed Subject Matter and Allowable Subject Matter*

Applicants thank the Examiner for the indication that claims 2, 9 and 10 are allowed and that claims 5 and 6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

To more fully claim the novel features of the present inventions canceled claims 1-12 and have replaced them with claims 13-36. The new claims incorporate the subject matter of the allowed claims and additionally include new dependent claims to further claim the novel aspects of the present invention. Applicants are providing herewith a list showing the correspondence between the new independent claims and the allowed independent claims and allowable dependent claims.

<u>Old Claim</u>	<u>New Independent Claim</u>
2 (Allowed)	13
5 (Allowable)	19
6 (Allowable)	23
9 (Allowed)	27
10 (Allowed)	31

Since new independent claims 13, 19, 23, 27 and 31 correspond exactly to allowed or allowable claims 2, 5, 6, 9, and 10, respectively, the new claims should therefore be allowable. Dependent claims 14-18, 20-22, 24-26, 28-30, and 32-35 should also be allowable for at least the same reasons.

Claim Rejections under 35 U.S.C. §103(a)

Claims 1, 3, 4, 7, 8, 11 and 12 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Jensen et al. (U.S. Patent No. 5,814,038) in view of Chader et al. (U.S. Patent No. 5,617,857).

As noted above, to expedite prosecution, claims 1,3, 4, 7, 8, and 12 have been cancelled without prejudice. Therefore the rejections of these claims are now moot. Applicants reserve the right to capture the subject matter of the canceled claims in a subsequently filed continuation or continuation-in-part application.

In regards to claim 11, (now rewritten as new claim 36), Applicants respectfully traverse the Examiner's rejection. Claim 36 is directed to a robotic surgical tool for use in a robotic surgical system having a processor which directs movement of a tool holder, the tool comprises a probe having a proximal end and a distal end, a surgical end effector disposed adjacent the distal end of the probe, and an interface disposed adjacent the proximal end of the probe. The interface comprises a portion of a drive system that is releasably coupleable with driving motors of the robotic surgical system the tool holder. Circuitry is mounted on the probe and transmitting a signal via the interface to the processor that indicates tool calibration offsets of the tool. Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness for the rejection of claim 36.

In particular, on page 3 of the Office Action, dated February 26, 2004, the Examiner asserts that "[s]ince Chader et al. teaches a device having the circuitry capable of sending information such as tool identification data, it is believed that the same circuitry is capable of sending information relating to the calibration offsets of the tool," and that "the manner in which a device is intended to be used does not differentiate the claimed apparatus from the prior art apparatus...".

Applicants note, however, that the circuitry recited in claim 36 is more than an "intended use," but is a structure and function of the circuitry. It is well settled in M.P.E.P. §2173.05(g) that "a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art

in the context in which it is used." The Examiner has not shown where Chader provides the claimed structure and function.

Moreover, the mere fact that Chader et al. may be "capable" of sending information related to the calibration offset of the tool is insufficient to establish a *prima facie* case. In order to establish obviousness under 35 U.S.C. § 103, every element of the claims must be shown and described, and there must be some suggestion or motivation to modify the reference. The Examiner has not met either of these requirements. Therefore, Applicants respectfully submit that claim 36 (previously claim 11) is allowable.

#### CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of the pending claims. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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By: Craig P. Wong  
Craig P. Wong  
Reg. No. 45,231

TOWNSEND and TOWNSEND and CREW, LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, CA 94111  
Tel: (206) 467-9600  
Fax: (415) 576-0300  
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